

10-11-06

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Kim, et al.

Serial No.: 10/780,339

Group Art Unit: 1636

Filed: 02/17/2004

Examiner: DUNSTON, Jennifer Ann

For: DETECTION AND IDENTIFICATION OF TOXICANTS BY MEASUREMENT
OF GENE EXPRESSION PROFILE

Attorney Docket No.: 3087.00013

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action dated September 11, 2006.

Restriction to one of the following Groups was required under 35 USC §121:

I. Claims 1-21 and 26-31, drawn to a screen for detecting the effects of chemicals on gene expression, comprising animal cleavage stage embryos, classified in class 435, subclass 6.

II. Claims 22-25, drawn to markers identified in a screen for detecting the effects of chemicals on gene expression, classified in class 536, subclass 23.1.

III. Claims 32-34, drawn to a treatment enabling the transfer of DNA to a membrane following gel electrophoresis, comprising depurinating the DNA, and denaturing the DNA, classified in class 435, subclass 6.

Applicants provisionally elect Group I, claims 1-21 and 26-31, for prosecution purposes, with traverse. Applicants hereby conditionally withdraw claims 22-25 and 32-34 from prosecution, without prejudice, and request reconsideration of the restriction requirement.

Applicants traverse the restriction requirement based on the following grounds. It is respectfully submitted that the restriction requirement practice was established to promote efficiency of prosecution in the Patent Office. All three groups of claims relate to screening for detection of effects of chemicals on gene expression. The claims of Groups I and III relate to a screen for detecting the effects of chemicals on gene expression and methods used in the screen (using a treatment enabling the transfer of biotinylated DNA to a membrane following gel electrophoresis) and moreover, are classified in the same class, 435, and the same sub-class, 6. Since there is a great amount of cross-classification amongst the sub-classes in this class, it is respectfully submitted that examination of all of the claims in a single application would be efficient, thereby promoting the grounds for the establishment of the restriction requirement practice. Hence, it is respectfully submitted that restriction should not be required and that Applicants have traversed the restriction requirement. However, as stated above, Applicants have elected the claims of Group I and provisionally withdrawn claims 22-25 and 32-34, without prejudice, pending reconsideration of the restriction requirement.

The application is now in condition for allowance, which allowance is respectfully solicited.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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Dated: October 10, 2006

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Connie Herty